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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,472

09/22/2003

Walter Beck

10191/3280

2949

26646

7590

04/24/2006

KENYON & KENYON LLP
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NEW YORK, NY 10004

EXAMINER

CLEVELAND, MICHAEL B

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,472

Applicant(s)

BECK ET AL.

Examiner

Michael Cleveland

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>032706</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/13/2006 has been entered.

Information Disclosure Statement

2. The information disclosure statement filed 3/27/2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (specifically JP 48-69731). It has been placed in the application file, but the information referred to therein has been only partially considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 4-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the new limitations that a gold bonding wire is contacted to the first metal.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (U.S. Patent 6,406,939, hereafter '939) in view of Zuniga-Ortiz et al. (U.S. Patent Application Publication 2003/0080392, hereafter '392) and Bayan et al. (U.S. Patent 6,372,539, hereafter '539).

Claims 1 and 6: '939 teaches an example which teaches
a method for producing a conductive coating on a dielectric (i.e., insulating) substrate
9col. 3, lines 43-53, comprising:

equipping, in selected regions, at least one surface of an electrically insulating substrate (401) with a coating of an electrically highly conductive first metal (402), the coating being structured as a printed circuit board;

cleaning the at least one coated surface (col. 6, lines 42-46);

seeding the coating with seeds of a second metal (Ni) and then depositing a layer including an alloy (Ni-P) of the second metal onto the coating seeded with the seeds of the second metal via electroless plating (col. 6, lines 50-55).

Claim 3: The electrolessly plated metal may include palladium alloys (col. 4, lines 6-11).

'939 does not explicitly teach that this substrate is subjected to firing. However, the examiner takes Official Notice that it is well known in the art of printed circuit components to

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fire components to bond them to one another after formation of the components. See, e.g., '939 col. 8, lines 34-40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have bonded the product of Example 2 to another substrate via a firing process because it is well known in the art to use such processes in order to join printed circuit components together.

'939 is discussed above. It teaches that the substrate may be a ceramic (col. 4, line 63-col. 5, line 2), but does not teach that the first metal includes silver. However, silver is a well known material for terminal bonding pads. See, e.g., '392, claim 23. therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a terminal pad including silver as the particular terminal pad of '939 with a reasonable expectation of success because '392 teaches that silver is a suitable material for terminal pads. The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

'939 teaches that the product may be subjected to connection technologies such as wire bonding, but '939 and '392 do not explicitly teach contacting a gold bonding wire to the first metal. However, '539 teaches that gold wires may be used as connection technologies for circuit components, and that gold forms a sufficient bond with silver (col. 4, lines 38-50). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a gold bonding wire as the particular connection technology of '939 for attaching at least one chip because '939 teaches that wire bonding is a conventional connection technology and because '539 teaches that gold wires in particular are suitable for successful bonding to silver.

Claims 4-5 and 7-8: Regarding the composition of the alloy, it has been held that "differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical." (MPEP 2144.05.II.A.)

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Response to Arguments

8. Applicant's arguments filed 2/13/2006 have been fully considered but they are not persuasive.

Applicant's arguments regarding the amended claims are unconvincing in view of newly cited Bayan '539.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brown (U.S. Patent 5,891,606), Lin (U.S. Patent 6,652,170), Yokono et al. (U.S. Patent 5,300,735), and Robinson et al. (U.S. Patent 6,054,172) are cited of interest for their teachings regarding electroless plating in the provision of printed circuit boards.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (571) 272-1418. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Cleveland
Primary Examiner
Art Unit 1762

4/20/2006